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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616
21906	7590	04/08/2005	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			TIEU, BINH KIEN	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28 and 31-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28 and 31-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 34, 40 and 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Davey (US Pat. #: 5,636,270).

Regarding claim 34, Davey teaches a thin like-card module or “card” as shown in figure 3 comprising:

a memory having stored therein a plurality of predetermined messages (i.e., corresponding addresses PB1, PB2, etc. storing caller’s name, address, account number, etc.” (col.12, line 66 – col.13, line 12 and col.14, lines 1-6), any of the predetermined messages available for selection to replace the caller ID value for the telephone at which the calling card is used.

Regarding claim 40, Davey teaches a thin like-card module or “card” as shown in figure 3 comprising:

a memory having stored therein a plurality of predetermined messages (i.e., corresponding addresses PB1, PB2, etc. storing caller’s name, address, account number, etc.” (col.12, line 66 – col.13, line 12 and col.14, lines 1-6) that are user-selectable, one or more of the user-selected messages to be received by a recipient communications device in place of the

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respective caller ID value for the telephone at which the calling card is used (col.14, lines 48-55 and col.16, lines 43-51).

Regarding claim 43, Davey further teaches limitations of the claim in col.9, lines 17.

Regarding claim 44, Davey further teaches limitations of the claim in col.13, lines 38-37.

Regarding claims 45 and 47, Davey further teaches limitations of the claim in 55-65.

Regarding claim 46, Davey further teaches the message contained "Mommy missed you" or similar meanings such as "I love you" in col.14, lines 2-4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 28, 31, 37-39 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Pat. #: 5,636,270) in view of Tasaki et al. (U.S. Pat. #: 4,879,744 as cited in the previous Office Action).

Regarding claim 28, Davey teaches a Produced Analog Telephone Signal (PATS) method (col.3, lines 1-11) for implementing on a thin card-like module as shown in figure 3 or one a "smart phone" as shown in figure 4. Davey teaches the thin card-like module as a card having storage to store analog telephone signals such as messages (col.12, line 66 – col.13,

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line 3). The selected analog telephone signal type or messages are recorded into the different address buttons (i.e., button "A", "D" and "C" on the Top Surface 61) corresponding addresses in the memory spaces (col.13, lines 4-12). The messages stored in the corresponding addresses, e.g., address P1 contained "Hi, honey. Mommy misses you; ..." (col.14, lines 1-6), PB2 contained of the caller's name, address, and account number (col.13, lines 55-60), etc. If the PATS method and means are implemented on a "smart phone", caller may select one of messages stored on the corresponding addresses of the memory to be used to replace the respective caller ID value of a telephone at which the card is used (col.14, lines 48-55 and col.16, lines 43-51).

It should be noticed that Davey further teaches the card memory can store information data of a credit card account (col.13, lines 40-44). Davey fails to clearly teach a memory having stored therein a unique identifying value having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card. However, Tasaki et al. ("Tasaki") teaches a telephone calling card comprising a memory having stored therein a unique identifying value (i.e., calling account number, card data, etc.), said memory having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card (col.1, line 48 – col.2, line 16) for purpose of automatically dialing for calling card services at subsequent uses.

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Therefore, it would have been obvious to one of ordinary skilled in the art the time the invention was made to incorporate the use of the features of such memory having stored therein a unique identifying value having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card, as taught by Tasaki, into view of Davey in order to speed up automatic dialing for calling card services.

Regarding claim 31, Tasaki further teaches limitations of the claim in col.1, lines 53-58.

Regarding claim 37, Tasaki further teaches limitations of the claim in col.1, lines 53-58, col.3, lines 39-46 and col.4, lines 26-32, line 2.

Regarding claims 38 and 41, Tasaki further teaches limitations of the claims in col.1, lines 48-52 and col.1, line 64 – col.2, line 2.

Regarding claims 39 and 42, Tasaki further teaches limitations of the claim in col.1, line 64 – col.2, line 2.

5. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Pat. #: 5,636,270) in view of Tasaki et al. (U.S. Pat. #: 4,879,744 Action) as applied to claim 28 above, and further in view of Snyder et al. (U.S. Pat. #: 5,784,444 also cited in the previous Office Action).

Regarding claim 32, Davey further teaches that the card can be inserted and stored messages into it memory via use of a programming device (col.12, line 66 – col.13, line 12).

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Davey and Tasaki, in combination, fails to clearly teach the feature of one of said plurality of predetermined message includes an indicator, which when selected, prompts the user to manually enter a message using the telephone at which the calling card is used. However, Snyder teaches such features in col.4, lines 57-56 for a purpose of indicating to called party for a purpose of the call.

Therefore, it would have been obvious to one of ordinary skilled in the art the time the invention was made to incorporate the use of the features of such one of said plurality of predetermined message includes an indicator, which when selected, prompts the user to manually enter a message using the telephone at which the calling card is used, as taught by Snyder, into view of Davey and Tasaki in order to provide update message to called party at the time of the call initiation.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Pat. #: 5,636,270) in view of Tasaki et al. (U.S. Pat. #: 4,879,744 Action) as applied to claim 28 above, and further in view of Taskett (U.S. Pat. #: 5,923,734 also cited in the previous Office Action).

Regarding claim 35, Davey and Tasaki, in combination, teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a

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purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or messages printed on the card, as taught by Taskett, into view of Davey and Tasaki in order to distinguish the message card with other standard calling cards.

7. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Pat. #: 5,636,270) in view of Taskett (U.S. Pat. #: 5,923,734 also cited in the previous Office Action).

Regarding claim 35, Davey teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or

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messages printed on the card, as taught by Taskett, into view of Davey in order to distinguish the message card with other standard calling cards.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Pat. #: 5,636,270) in view of Snyder et al. (U.S. Pat. #: 5,784,444).

Regarding claim 36, Davey further teaches that the card can be inserted and stored messages into it memory via use of a programming device (col.12, line 66 – col.13, line 12). Davey and Tasaki, in combination, fails to clearly teach the feature of one of said plurality of predetermined message includes an indicator, which when selected, prompts the user to manually enter a message using the telephone at which the calling card is used. However, Snyder teaches such features in col.4, lines 57-56 for a purpose of indicating to called party for a purpose of the call.

Therefore, it would have been obvious to one of ordinary skilled in the art the time the invention was made to incorporate the use of the features of such one of said plurality of predetermined message includes an indicator, which when selected, prompts the user to manually enter a message using the telephone at which the calling card is used, as taught by Snyder, into view of Davey in order to provide update message to called party at the time of the call initiation.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sasaki (U.S. Pat. #: 5,652,606) teaches a message card stored different messages.

Nagata et al. (US. Pat. #: 4,677,657) teaches voice recording card that is used to record caller voice to be sent to recipient at the time of a call.

Response to Arguments

10. Applicant's arguments with respect to claims 28 and 31-42 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications; please mark
"EXPEDITED PROCEDURE")

Or:

If it is an informal or draft communication, please label
"PROPOSED" or "DRAFT")

Customer Service (571) 272-2600

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

A handwritten signature in black ink, appearing to read "Binh K. Tieu", with a stylized flourish at the end.

**BINH TIEU
PRIMARY EXAMINER**

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Date: April 01, 2005